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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
JEAN-LUC DUBOIS
Serial No.: 194,996
Filed: December 4, 1998
For: TRANSDERMIC...MEDICAMENTS

: L.E. Smith

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600 Third Avenue
New York N.Y. 100
March 21, 2000

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Asst. Commissioner for Patents
Washington, D.C. 20231

RENEWED PETITION

Sir:

Responsive to the decision on the petition dated February 14, 2000, Applicant renews the petition to accept the application under the provisions of Rule 1.47.

In the decision on the earlier petition, the Examiner indicated that items 1 and 6 relating to the fee and a showing that action was necessary to preserve the rights of the Applicant had been satisfied. With respect to the other four requirements, the Examiner objected to the same. With respect to item 2 relating to the inventor's refusal to execute the application, this is believed to be clearly pointed out with respect to the new declaration of Mr. Vieillefosse filed herewith. Mr. Vieillefosse specifically states that after the applications and assignments had been forwarded to the inventor at his new place of employment, he refused to execute the same. This was passed to Mr. Vieillefosse during several telephone conversations with him. Therefore, it is deemed that Applicant has now complied with requirement No. 2.

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With respect to the statement of the last known address of the inventor, Mr. Vieillefosse's declaration clearly states that Mr. Dubois has refused to provide his present address and Applicant has supplied the mailing address for Mr. Dubois at his place of employment which should satisfy requirement No. 3. The last address of Mr. Dubois was set forth in Mr. Vieillefosse's previous declaration but this address is no longer valid.

With respect to the declaration of record, it is deemed that Mr. Vieillefosse's declaration submitted with the initial petition clearly satisfies the provisions of the fourth requirement since Mr. Vieillefosse's present declaration unequivocally states that among his duties as head of the patent department of Hoechst Marion Roussel, he is authorized to execute legal documents relating to patent matters including declarations and therefore, the record is now clear with respect to requirement No. 4.


With respect to Applicant's having proprietary interest in the application, it should be noted that Applicant has filed the various employment papers including a copy of the French law and an English translation thereof and a copy of the employment contract and the translation thereof. The French law states that the inventor is required to assign inventions to his employer as well as his employment also clearly and unequivocally states that he is required to execute the same. Moreover, Mr. Vieillefosse's declaration clearly shows that he is a European patent attorney as

well as a licensed French patent agent and unequivocally states that based on the documents already of record, Mr. Dubois is required to assign all inventions to Hoechst Marion Roussel and therefore, this means that Applicant has clearly demonstrated by proof that they have sufficient proprietary interest in the application.

Therefore, it is requested that the Patent Office reconsider the petition and grant the same.

Respectfully submitted,
Bierman, Muserlian and Lucas

By:


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CAM:ds
Enclosures